

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: J. Leighton Read, Stephen P.A. Fodor, Lubert Stryer and Michael C. Pirrung

Application No.: 09/654,948

Group Art Unit: 1639

Filed: September 1, 2000

Examiner: Ponnaluri, P.

Confirmation No.: 7877

Title: Polypeptide Array Synthesis

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SUPPLEMENTAL INFORMATION DISCLOSURE STATEMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This Information Disclosure Statement is submitted:

☐ under 37 CFR 1.129(a), or
(First/Second submission after Final Rejection)

☒ under 37 CFR 1.97(b), or
(Within any one of the following time periods: three months of filing national application (other than a CPA) or date of entry of the national stage in an international application; or before the mailing date of a first office action on the merits in a non-provisional application, including a CPA, or a Request for Continued Examination).

☐ under 37 CFR 1.97(c) together with either:
☐ a Statement under 37 CFR 1.97(e), as checked below, or
☐ a \$180.00 fee under 37 CFR 1.17(p), or
(After the 37 CFR 1.97(b) time period, but before final action or notice of allowance, whichever occurs first)

☐ under 37 CFR 1.97(d) together with:
☐ a Statement under 37 CFR 1.97(e), as checked below, and
☐ a \$180.00 fee under 37 CFR 1.17(p), or
(Filed after final action or notice of allowance, whichever occurs first, but on or before payment of the issue fee)

☐ under 37 CFR 1.97(i):
Applicant requests that the IDS and cited reference(s) be placed in the application filewrapper.
(Filed after payment of issue fee)

Statement Under 37 CFR 1.97(e)

- ☐ Each item of information contained in this Information Disclosure Statement was first cited in any communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of this Information Disclosure Statement; or
- ☐ No item of information contained in this Information Disclosure Statement was cited in a communication from a foreign patent office in a counterpart foreign application, and, to the knowledge of the undersigned, after making reasonable inquiry, no item of information contained in the information disclosure statement was known to any individual designated in 37 CFR 1.56(c) more than three months prior to the filing of this Information Disclosure Statement.

Statement Under 37 CFR 1.704(d) (Patent Term Adjustment)

Applies to original applications (other than design) filed on or after May 29, 2000

- ☐ Each item of information contained in the Information Disclosure Statement was cited in a communication from a foreign patent office in a counterpart application and this communication was not received by any individual designated in § 1.56(c) more than thirty days prior to the filing of the Information Disclosure Statement.
- ☒ Enclosed herewith is form PTO-1449:
- ☒ Copies of the cited references are enclosed.
- ☐ Since this application was filed after June 30, 2003, copies of issued U.S. patents and published U.S. applications are not required and are not being provided.
- ☐ Copies of the cited references are enclosed except those entered in prior application, U.S. Application No. [], to which priority under 35 U.S.C. 120 is claimed. [The earlier application contains copies of the cited references.]
- ☐ The listed references were cited in the enclosed International Search Report in a counterpart foreign application.
- ☐ The "concise explanation" requirement (non-English references) for reference(s) [] under 37 CFR 1.98(a)(3) is satisfied by:
- ☐ the explanation provided on the attached sheet.
- ☐ the explanation provided in the Specification.
- ☐ submission of the enclosed International Search Report.
- ☐ submission of the enclosed English-language version of a foreign Search Report and/or foreign Office Action.
- ☐ the enclosed English language abstract.

☐ Applicant requests that the following non-published pending applications be considered:

Examiner's
Initials

_____ U.S. Patent Application No. [], by [inventor(s)], filed [], Docket No.: []

_____ U.S. Patent Application No. [], by [inventor(s)], filed [], Docket No.: []

_____ U.S. Patent Application No. [], by [inventor(s)], filed [], Docket No.: []

Examiner

Date

- ☐ A copy of each above-cited application, including the current claims, is enclosed.
- ☐ A copy of each above-cited application, including the current claims, is enclosed, except those entered in prior application, U.S. Application No. [], to which priority under 35 U.S.C. 120 is claimed.

The Examiner is requested to return a copy of the above list of pending applications indicating which references were considered with the next office communication.

It is requested that the information disclosed herein be made of record in this application.

Method of payment:

- ☐ A check for the fee noted above is enclosed, or the fee has been included in the check with the accompanying Reply. A copy of this Statement is enclosed.
- ☐ Please charge Deposit Account 08-0380 in the amount of \$[]. A copy of this Statement is enclosed.
- ☒ Please charge any deficiency in fees and credit any overpayment to Deposit Account 08-0380.

REMARKS

The current Supplemental IDS incorporates references that have been disclosed in recent litigation.

Additionally, Applicants would like to notify the Examiner of inter party matters that relate to the present application. Two commonly owned patents US 5,744,305 and US 5,800,992 have been involved in interference proceedings. Specifically, the interferences were Interference No. 104,359 between commonly owned US 5,744,305 and Brown et al., USSN 08/688,488, and Interference No. 104,358 between commonly owned US 5,800,992 and USSN 08/514,875. Both interferences have been decided (subject to current appeal in District Court of Northern California, Civil Case No. C99 21111-JF/EAI) by the USPTO in favor of real party in interest Affymetrix, the assignee of the present application. The Junior party challenged the patents on the basis of lack of enablement and written description under 35 USC §112, among other issues. The Junior party's initial position is set out in papers (with supporting information) entitled "Request for Declaration of Interference, 37 C.F.R. §1.608" in both interferences. The initial response of Senior party Patentee is set out in papers (with supporting information) entitled "Fodor's Opposition to Brown's Rule 608(b) Request" in both interferences.

Further, US 5,744,305, US 5,445,934 and US 5,800,992 have been the subject of litigation (*Affymetrix, Inc. v. Hyseq, Inc.*, US District Court for the Northern District of California, San Francisco Division, Civil Action No. C98-03192 FMS, and *Affymetrix, Inc. v. Synteni, Inc. and Incyte Pharmaceuticals, Inc.*, US District Court for the Northern District of California, San Francisco, Case No. C98-4508 FMS (MEJ)). In the course of these proceedings, allegations of invalidity over prior art, lack of enablement, lack of support and inequitable conduct (relating to duty of candor, content of declarations under 37 CR §1.132, and arguments made during prosecution) were raised. These allegations were denied. In a more recent lawsuit with Incyte Genomics (*Incyte Genomics Inc. v. Affymetrix*, U.S. District Court, Northern district of California, San Francisco division and is Case No. C 00-3210 JF.), Affymetrix counterclaimed for patent infringement under U.S. patent 5,871,928 ('928) and 6,040,193. Incyte has filed their "Initial Disclosure of Prior Art" and the references cited therein have been included into the current IDS.

All of the above lawsuits have been settled. Prior to settlement, there was a Markman decision regarding the '305 and '934 patents but no decision on the merits. In the '992 patent, the court held that the claim term "substantially complementary" was indefinite and there was lack of written description for the word "mixture" in the claims of the '992 patent. No substantive decisions were made in the lawsuit involving the '928 and '193 patents.

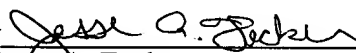
Further, oppositions have been filed against a related European application EP 619,321 in the European Patent Office, and a revocation proceeding was brought in the United Kingdom against related patents GB 2,248,840 and EP (UK) 0619 321. Applicants can provide copies of litigation documents that may be of interest to the Examiner, but have not done so due to the extensive nature of the multiple litigation and papers filed therein. The revocation proceedings have been settled without any decision on the merits.

Applicants also wish to identify two other interferences that was declared and settled between applications that are related to the present application. The application serial number is 09/063,933 and the interference is declared with U.S. Patent No. 6,054,270 (E. Southern). The Interference No. was 104,658. The interference has been settled with priority for certain claims to Southern. However, other claims not corresponding to the interference count have been allowed to applicants from the '933 application. The second interference involves application serial number USSN 09/614,068 and the interference was declared with U.S. Patent Nos. 5,922,534 (K. Lichtenwalter) and 6,255,053 (K. Lichtenwalter). The Interference Number was 105,089, but it has subsequently been terminated due to a motion of patent invalidity based on prior art. Both Agilent patents were invalidated and the Affymetrix claims that were copied from the two patents were declared unpatentable.

Respectfully submitted,

HAMILTON, BROOK, SMITH & REYNOLDS, P.C.

By



Jesse A. Fecker

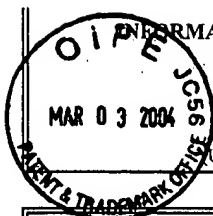
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Dated: 3-1-04



INFORMATION DISCLOSURE CITATION
IN AN APPLICATION

January 29, 2004

Use several sheets if necessary)

FIRST NAMED INVENTOR
I. Leighton Read

FILING DATE
September 1, 2000

EXAMINER
P. Ponnaluri

CONFIRMATION NO.
7877

GROUP
1639

U.S. PATENT DOCUMENTS

EXAM- INER INI- TIAL	REF. NO.	DOCUMENT NUMBER Number-Kind Code (if known)	ISSUE DATE / PUBLICATION DATE MM-DD-YYYY	NAME OF PATENTEE OR APPLICANT OF CITED DOCUMENT
	AF2	5,837,832	11-17-1998	Chee <i>et al.</i>
	AG2	3,642,450	02-15-1972	Eriksson
	AH2	5,688,642	11-18-1997	Chrissey <i>et al.</i>
	AI2	4,996,142	02-26-1991	Al-Hakim <i>et al.</i>
	AJ2	5,412,087	05-02-1995	McGall <i>et al.</i>
	AK2	4,563,417	01-07-1986	Albarella <i>et al.</i>

FOREIGN PATENT DOCUMENTS

		DOCUMENT NUMBER Country Code-Number-Kind Code (if known)	DATE MM-DD-YYYY	NAME OF PATENTEE OR APPLICANT OF CITED DOCUMENT	TRANSLATION YES NO

OTHER DOCUMENTS (Including Author, Title, Date, Pertinent Pages, Etc.)

	AU2	Southern, E.M., <i>et al.</i> , "Analyzing and Comparing Nucleic Acid Sequences by Hybridization to Arrays of Oligonucleotides: Evaluation Using Experimental Models, <i>Genomics</i> , 13: 1008-1017 (1992).
	AV2	Maskos, U., and Southern, E.M., "Parallel Analysis of Oligodeoxyribonucleotide (oligonucleotide) Interactions. I. Analysis of Factors Influencing Oligonucleotide Duplex Formation, <i>Nucleic Acids Research</i> , 20(7): 1675-1678 (1992).
	AW2	Wetmer, J.G., "Light-Directed, Spatially Addressable Parallel Chemical Synthesis," <i>Chemtracts-Biochem Mol. Biol.</i> , 2: 207-210 (1991).
	AX2	Chow, T., <i>et al.</i> , "A High Capacity, Reusable Oligodeoxythymidine Affinity Column, <i>Analytical Biochemistry</i> , 175: 63-66 (1988).
	AY2	Dunn, A.R., and Sambrook, J., "Mapping Viral mRNAs by Sandwich Hybridization, <i>Methods in Enzymology</i> , 65: 468-478 (1980).

EXAMINER

DATE CONSIDERED

SUPPLEMENTAL INFORMATION DISCLOSURE CITATION IN AN APPLICATION		FIRST NAMED INVENTOR J. Leighton Read		FILING DATE September 1, 2000
January 29, 2004 (Use several sheets if necessary)		EXAMINER P. Ponnaluri	CONFIRMATION NO. 7877	GROUP 1639

OTHER DOCUMENTS (Including Author, Title, Date, Pertinent Pages, Etc.)		
AZ2	Weetall, H.H., "Covalent Coupling Methods for Inorganic Support Materials, <i>Methods in Enzymology</i> , 44: 134-148 (1976).	
AR3	Rentrop, M., <i>et al.</i> , "Aminoalkylsilane-treated Glass Slides as Support for <i>in situ</i> Hybridization of Keratin cDNAs to Frozen Tissue Sections Under Varying Fixation and Pretreatment Conditions, <i>Histochemical Journal</i> , 18: 271-276 (1986).	
AS3	Matteucci, M.D. and Caruthers, M.H., "Synthesis of Deoxyoligonucleotides on a Polymer Support, <i>J. Am. Chem. Soc.</i> , 103: 3185-3191 (1981).	
AT3	Kessler, "Nonradioactive Labeling Methods for Nucleic Acids," <i>Nonisotopic DNA Probe Techniques</i> , edited by Larry Kricka, Chapter 2, pp. 29-92 (1991).	
AU3	Dyson, N.J., "Immobilization of Nucleic Acids and Hybridization Analysis," <i>Essential Molecular Biology Volume II: A Practical Approach</i> , edited by T.A. Brown, Chapter 5, pp. 111-156 (1991).	
AV3	Maniatis, <i>et al.</i> , "Molecular Cloning A Laboratory Manual," pp. 313-315 and 326-328 (1982).	
AW3	Jonsson, <i>et al.</i> , "Surface Immobilization Techniques in Combination with Ellipsometry," <i>Methods in Enzymology</i> , 137: 381-388 (1988).	
AX3	Davis, <i>et al.</i> , "Basic Methods in Molecular Biology." pp. 62-65, 68 and 75-78 (1986).	
AY3	"Chapter 6: Chemistry for Automated DNA/RNA Synthesis," in <i>Applied Biosystems Models 392 and 394 DNA/RNA Synthesizers: Users Manual Applied Biosystems</i> , (1991).	
AZ3	"Van Nostrand Reinhold: Encyclopedia of Chemistry (4 th ed.)," pg. 366 (1984).	
AR4		

EXAMINER	DATE CONSIDERED
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